

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Franz Lindlbauer

Serial No.: 10/598848

Filed: 9/13/2006

For: MULTI-WALLED, SACK-TYPE PACKAGING

Attorney Docket No.: WAS 0808 PUSA

Group Art Unit: 3728

Examiner: Andrew D. Perreault

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer mailed on September 24, 2009 for the above-identified patent application.

INTRODUCTION

There are two issues for review on appeal:

1. whether claims 10-20 are unpatentable under 35 U.S.C. § 112 ¶ 1 for failing to comply with the written description requirement, the Examiner taking the position that the specification does not contain the 'self-sealing' limitation added to claim 10; and
2. whether claims 10-20 are unpatentable under 35 U.S.C. § 103(a) over *Combrink* (US 5,493,844) in view of *Barnes et al.* (US 4,672,684) and *Scoville, Jr.* (US 4,596,696).

The rejections are predicated on errors of fact and law in the Examiner's analysis.

Accordingly, the objectives of this Reply are to:

- (a) identify these errors;
- (b) demonstrate that these rejections are improper; and
- (c) urge that they be reversed.

FUNDAMENTAL ERRORS IN THE EXAMINER'S ANALYSIS

A. Error No. 1 – Claims 10-20 Fail to Pass Muster Under 35 U.S.C. § 112, ¶ 1

Claim 10 is an apparatus claim that calls for two layers in an overlap region of a multi-layer, self-sealing packaging sack to lie "... one above the other in the overlap region [so that they] bear against each other forming a self-sealing seal". Claims 11-20 depend upon claim 10, and were therefore rejected.

Appellant argues that claim 1 is supported by the original specification which states that "the opening in the overlap region is closed by the inherent weight of the filled packaging medium".

The Examiner appears to misunderstand the structure and function of the overlapping region. The application as filed explicitly states that "during storage of the filled sacks, the opening in the overlap region is closed by the inherent weight of the filled packaging medium, with the effect that no atmospheric moisture or spray can enter the interior by the perforation". Specification, p. 4, lines 32-37.

The written description requirement for a claimed invention may be satisfied through sufficient description of a representative number of species by disclosure of relevant identifying characteristics, i.e., structure or other physical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show that the applicant was in possession of the invention. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ 2d. at 1406. See also MPEP § 2163 (II)(A)(3)(a)(ii). As discussed here and in the appeal brief, the written description requirement has been met.

In light of clear support in the specification (which includes the claims), which states that the purpose of the packaging medium is to "... transport and [store] particulate material" (claim 8) and the "moisture-sensitive material" (claim 9), one wonders whether the Examiner is demanding more than previously cited case law. *In haec verba* is not the standard.

The Examiner also states that "... there is no inherent weight within the claimed sack to self-seal it". The Examiner's Answer, p. 8. The specification describes the filling materials. Inherently, the filling material has weight.

It is a matter of common knowledge in the packaging industry that a package's contents exert a pressure that assists in filling out the cavity within the package. This outward force is harnessed in the present invention by causing a bordered overlapping region to seal. This

basic function appears not to be understood by the Examiner, and is self-evident from a routine knowledge of the industry.

The § 112 ¶ 1 rejection should therefore be reversed.

B. Error No. 2 – Claims 10-20 are Obvious Under 35 U.S.C. § 103

The Examiner is of the view that Claims 10-20 are obvious over an inviable combination of three references.

1. The Non-Analogous Art Problem

At least the tertiary reference (*Scoville*) lies in non-analogous art. Therefore it cannot be used to reject the claims of the application (citations omitted).

Scoville is directed to a disposable sterilizer test pack of rigid cardboard perforated with slots. It has a "tell-tale" thermal indicator to test the effectiveness of a vacuum autoclave sterilization. His package is rigid, not sack-like. It is not designed to be filled with a powdery material. The Examiner is of the view that *Scoville* lies in the field to which reference can be made in supporting an obviousness rejection. Yet the field of endeavor of the reference is completely different from that of the Applicant.

2. The Failure to Make a Prima Facie Case

KSR has stated that an invention may be obvious when there is a design need or market pressure to solve a problem and there are a finite number of identified predictable solutions. The Examiner has failed to make a *prima facie* case of obviousness because no reason has been cited in the references of record for making a combination on which the Examiner relies to support his obviousness rejection.

For the reasons expressed in the Appeal Brief, (1) the references cannot be physically combined; and (2) if made, the proposed combination would differ in non-obvious ways from the claimed invention.

Any one or more of the errors discussed above is sufficiently material to reverse the Examiner's rejections. These errors, taken in the aggregate, demonstrate a flawed examination.

Respectfully submitted,

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